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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/313,436	05/17/1999	DAVID S. SPRINGER	M-7260US	3911

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EXAMINER
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LE, KHANH H

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/313,436

Applicant(s)

SPRINGER ET AL.

Examiner

Khanh H. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,4-6,8,9 and 26-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4-6, 8-9, and 26-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**Detailed Action/ Continued Examination Under 37 CFR 1.114**

1. A request for continued examination under 37 CFR 1.114, filed 11/22/04, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/22/04 has been entered.

2. As requested, amendments to claims 1, 4, and 26, cancellation of claim 7 and addition of new claims 28-31 have been entered.

Thus claims 1, 4-6, 8-9, and 26-31 are now pending in the application. Claims 1 and 26 are independent. Applicants are requested to confirm that no new claim 32 had been submitted contrary to the assertion on line 1 at page 2 of the amendment dated 9/28/04.

**Claim Rejections 35 USC 112**

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

*The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.*

4. **Claims 1, 26 and their dependents are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.** The claim(s) contains subject matter which was not described in the specification in such a way as to

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reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

From the scant details given the specifications at page 7, it is not clear how pricing of the advertisements is done based on the tracking of the number of times the user identifier is located. Is it pricing to reward the user for viewing the ad or pricing to bill the advertiser? Appropriate correction is required.

Also it is not clear how “based on the number of times the database locates the identifier, the database: determining which advertisements are transmitted to the user,” is done and why. Because of the lack of specifications details, it is not reasonably conveyed to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

*The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.*

**6. Claims 1, 26 and all their dependents are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.**

Claims 1 and 26 : as to pricing step , it is not clear if pricing to reward the user for viewing the ad or pricing to bill the advertiser is involved. As to the step of “based on the number of times the database locates the identifier, the database: determining which advertisements are transmitted to the user,” this determining step may mean : determining which advertisements “have been” transmitted to the user just prior to a certain count of logging- on has been determined and not that the deciding (i.e. determining) step is based on the identifier counts. Appropriate correction/clarification is required . For prior art application purposes, it is interpreted that the deciding (i.e. determining) step is based on the identifier counts.

**Response to Remarks**

7. Applicant's arguments have been fully considered but they are not moot. In view of the amendments, the previous art rejections are withdrawn and new prior art rejections apply (see below).

***Claim Rejections - 35 USC § 103***

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. **Claims 1, 4-5, 8-9, 26-28, 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guyot, US 6,119,098 herein Guyot in view of Jenkins, US 6285983, hereinafter Jenkins.**

As to claims 1, 8, 26, and 30, Guyot discloses

A method of tracking information provided to a computer system from an advertisement database and associated server, the method comprising:

providing an identifier unique to the computer system, (see at least col. 3 lines 18-22, 25-30, 55-65 ; Fig. 3 and associated text),

the database associating the identifier with information specific to a computer user associated with the computer system (see at least Fig. 5 and associated text; col. 3 lines 18-22, 25-30, 55-65)

;

the computer user establishing a web connection with the server and transmitting the identifier to the database (see at least Fig. 5 and associated text);

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the user logging on to a combination advertisement broker server(see at least Fig. 5 and associated text),

the computer system transmitting the identifier and requesting that a banner advertisement be displayed on the computer system (see at least col. 3 lines 25-30 )

the database checking for the identifier (inherent in the system; see at least col. 3 lines 55-65) ;

a counter accounting for the presence of the identifier (inherent in the system; a count of one is at least done; see at least col. 3 lines 55-65) ;

and

based on the number of times the database locates the identifier, the database:

determining which advertisements are transmitted to the user (see at least Figs. 5, 8 and associated text; col. 8 lines 51-65, col. 6 line 64 to col. 7 line 11, col. 3 lines 64-col. 4 lines 16 : the server database counts each ad seen by each subscriber with each ad designed to be shown a particular subscriber a maximum number of times per subscriber and within a time period only; therefore by locating the subscriber ID, at least once, the server database can determine which advertisement not to send if already seen ,and which new ads can be sent)

providing tracking for pricing the advertisements (see at least col. 10 lines 11-29 : billing the advertisers)

; and

determining bonus incentives to the user associated with the identifier (see at least col. 6 lines 6-29 :credits given).

Guyot does not specifically disclose the identifier is stored on a (the user's) hard drive (claims 8 and 30 ) or is imbedded in the user computer hardware (claim 1) However, in the analogous advertising art, Jenkins discloses that

*"As is known in the art, cookie files may be installed by a web site server on the computer hard disk drive of a browsing consumer"* (see at least col. 1 lines 18-39).

It would have been obvious to one skilled in the art at the time the invention was made to install the cookie file on the user hard drive to implement the user ID method of Guyot because such cookie implementation technique is well-known (typical) as stated in Jenkins.

As to claims 4, 27 (dependent on claims 1 and 26 respectively), Guyot discloses the server hosting the advertisements and informational data. (see at least the abstract, advertisements are also informational data).

As to claims 5 and 28 (dependent on claims 1 and 26 respectively), Guyot discloses the database searching and locating advertisements that match criteria provided by the computer user during a querying procedure (see at least col. 3 lines 55-65; Fig. 8 step S 601 and associated text)

As to claims 9 and 31 (dependent on claims 1 and 26 respectively), Guyot does not specifically disclose the information specific to the computer user includes one of incentives, bonuses and discounts on a plurality of goods , however it discloses targeted ads ( abstract ). Official Notice is taken that it is well-known and customary to advertisements often include promotional offers, such as product or service discounts and vouchers to promote consumption. It would have been obvious to one skilled in the art at the time the invention was made to add targeted discounts to Guyot's targeted ads for the above-stated advantage.

**10. Claims 6 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guyot in view of Jenkins, and further in view of Marsh et al. , US 5848397, herein Marsh.**

As to claims 6 and 29 (dependent on claims 5 and 28 respectively), Guyot does not specifically disclose that if no matching criteria is found, the database transmitting one of generic advertisements and no advertisements. However, in analogous arts, Marsh discloses that default (generic) ads or no ads are displayed when no other criteria for display are met (see at least col. 13 lines 40-53) as a display default method. It would have been obvious to one skilled in the art at the time the invention was made to add this display default method to Guyot for the above-stated advantage.

### **Conclusion**

11. All prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 703-305-0571. The Examiner works a part-time schedule and can best be reached on Tuesday-Wednesday 9:00-6:00. The examiner can also be reached at the e-mail address: [khanh.le2@uspto.gov](mailto:khanh.le2@uspto.gov). ( However, Applicants are cautioned that confidentiality of email communications cannot be assured.)

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 703-305-8469. (After our Art Unit moves to the Alexandria campus, sometime during or after April 2005, the Examiner's phone number will be 571-272-6721 and Mr. Eric Stamber's will be 571-272-6724. The current numbers are still in



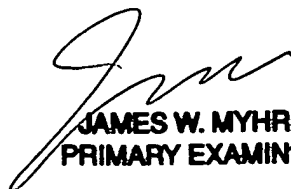
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service until the move). The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

*KHL*  
February 2, 2005

KHL

  
**JAMES W. MYHRE**  
**PRIMARY EXAMINER**